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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,712	03/29/2001	Takashi Shinzaki	1075.1156	4094

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1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/819,712

Applicant(s)

SHINZAKI, TAKASHI

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's "Amendment" filed on June 10, 2005 has been considered with the following effect.

Applicant's response by virtue of amendment to claim 1 has overcome the Examiner's rejection of such claims under 35 USC 112, second paragraph.

Claims 19-64 are canceled. New claim 65 is added. Claim 1 is amended. Claims 1-18 and 65 remain pending and an action on the merits of these follows.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 65 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts"

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has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject

matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele

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test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claim 65 has no connection to the technological arts. None of the steps indicate any connection to a computer or technology. The steps of receiving, and assigning are broadly interpreted as manual steps. Therefore, the claims are directed towards non-statutory subject matter, i.e. not within technological arts. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as using a digital computing device.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites marketing information which includes the information of age/sex of the customer. Since claim 1 recites an

anonymous order, how can marketing information be gathered between the customer and the seller. Examiner will examine the claim as broadly reasonable interpreted.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,807,530 to Shub et al.**

Regarding claims 1, Shub disclose an e-commerce method for an e-commerce system, which includes a seller's terminal (merchant, col. 1, lines 55-57; col. 2, lines 3-3; Figure 1; col. 3, lines 43-44), a customer's terminal (customer, col. 1, lines 55-57; col. 2, lines 3-5; Figure 1; col. 3, lines 40-44), a payment agent's terminal (payment agency; Figure 1; col. 2, lines 3-5); and commodity delivery means (delivery companies; col. 2, lines 3-5), the method comprising: at the customer's terminal sending an anonymous order (anonymous buy) to the seller's terminal for a commodity via the information communication network and designating a non-residential place other than a residential place (alternate address, col. 6, lines 54-56; col. 2, lines 53-57) of the customer as the delivery destination via the communication network (col. 3, lines 9-12; col. 6, lines 43-61); at the seller's terminal assigning transaction identification (ID) information (order

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number) peculiar to said anonymous order and notifying the customer's terminal of said transaction ID information (col. 6, lines 54-56; col. 2, lines 47-53), requesting the payment agent's terminal for payment for the commodity for which the customer's terminal made the anonymous order (col. 2, lines 49-53; col. 4, lines 40-43; col. 6, lines 50-53), making arrangements to deliver the commodity to the non-residential place using the commodity delivery means (col. 2, lines 53-col. 3, line 3; col. 6, lines 53-61; col. 7, lines 6-9); and at the commodity delivery means transferring the commodity to a receiver for the commodity at the non-residential place (col. 3, lines 8-12).

Regarding claim 65, Shub discloses a method for conducting electronic commerce, comprising: receiving an anonymous purchaser order; and assigning transaction identification information to the anonymous purchase order (abstract; col. 6, lines 44-61).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-6, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. in view of U.S. Patent No. 6,336,100 to Yamada.**

Regarding claims 2-6, Shub substantially discloses the claimed invention, however, it does not disclose certification; the receiver certifying information which his



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created at the sellers' terminal and price information of the transaction, together with the transaction ID information are notified to the customer's terminal; the customer's terminal notifies the payment's agent terminal of the transaction ID information and the price information, which have been notified by the seller's terminal; customer's terminal notifies the seller's terminal of receiver certifying information; a sales slip medium containing said transaction ID information in form of a read-out code; and the receiver for the commodity is certified as the authorized receiver, by reading out the transaction ID information of the sales slip medium; the transaction ID information is ciphered with the read-out code as a code key; and the ciphered transaction ID information of the sales slip medium is deciphered using the code key.

Shub discloses a method of enabling a customer to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant (col. 1, lines 9-12). Shub further teaches a private key/public key pair and a secret encoding key (col. 2, lines 26-28). Furthermore, Shub discloses the customer has the option to request the order to be delivered to an alternate address (col. 2, lines 53-55). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair (c, t) (col. 5, lines 60-63).

Yamada, on the other hand, teaches an online shopping system which a customer can designate addresses or places where he or she wants to have goods delivered (col. 1, lines 19-22). Yamada further teaches the certification (col. 3, line 66 – col. 4, line 3); the receiver certifying information which his created at the sellers' terminal and price information of the transaction, together with the transaction ID information are

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notified to the customer's terminal (col. 2, lines 59-60; col. 3, lines 1-5; col. 3, lines 55-65); the customer's terminal notifies the payment's agent terminal of the transaction ID information and the price information, which have been notified by the seller's terminal (col. 2, lines 59-60; col. 3, lines 1-5; Figures 11-12); customer's terminal notifies the seller's terminal of receiver certifying information (col. 3, line 55-col. 4, line 4); a sales slip medium containing said transaction ID information in form of a read-out code (receipt, Figure 12); and the receiver for the commodity is certified as the authorized receiver, by reading out the transaction ID information of the sales slip medium (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6); the transaction ID information is ciphered with the read-out code as a code key (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6, Figure 12); and the ciphered transaction ID information of the sales slip medium is deciphered using the code key (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6, Figure 12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the certification, as taught by Yamada, in order to deliver the commodity satisfactorily to the customer (Yamada, col. 5, lines 12-13), thus providing an effective delivery system (Yamada, col. 5, lines 28-29).

Regarding claims 11-13 and 15, Shub substantially disclose the claimed invention, however, it does not disclose upon completion of delivery of the commodity of the non-residential place, the seller's terminal notifies the customer's terminal of the completion of the delivery; certification is made as to whether the receiver for the

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commodity is an authorized receiver, using receiver certification information; notifying the customer's terminal of a status of delivery of the commodity; and notification to the seller's terminal via communication network that the transferring of the commodity has been carried out in the commodity transferring step.

Shub discloses a method of enabling a customer to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant (col. 1, lines 9-12). Shub further teaches a private key/public key pair and a secret encoding key (col. 2, lines 26-28). Furthermore, Shub discloses the customer has the option to request the order to be delivered to an alternate address (col. 2, lines 53-55). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair (c, t) (col. 5, lines 60-63).

Yamada, on the other hand, teaches upon completion of delivery of the commodity of the non-residential place, the seller's terminal notifies the customer's terminal of the completion of the delivery (col. 3, lines 43-65); certification is made as to whether the receiver for the commodity is an authorized receiver, using receiver certification information (col. 2, lines 57-65; col. 3, line 66- col. 4, line 3); notifying the customer's terminal of a status of delivery of the commodity (col. 3, lines 46-47); and notification to the seller's terminal via communication network that the transferring of the commodity has been carried out in the commodity transferring step (col. 3, lines 43-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the notification and certification, as taught by Yamada, in order to deliver the commodity satisfactorily to

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the customer (Yamada, col. 5, lines 12-13), thus providing an effective delivery system (Yamada, col. 5, lines 28-29).

**Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. and U.S. Patent No. 6,336,100 to Yamada as applied to claim 1 above, and further view of U.S. Patent No. 6,236,972 to Shkedy.** Shub and Yamada substantially disclose the claimed invention, however, the combination does not disclose digital signature and biometrics. The combination discloses member discriminating information that discriminates account settlement systems (Yamada, col. 2, lines 59-65). Furthermore, the combination discloses the service provider issues ID cards storing the member discriminating information (Yamada, col. 2, lines 59-65). Shkedy, on the other hand, teaches digital signatures and biometrics (col. 5, lines 3-7).

Therefor, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Shub and Yamada, to include digital signatures and biometrics, as taught by Shkedy, so as to authenticate the customer identification (Shkedy, col. 5, lines 3-4).

**Claim 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. and U.S. Patent No. 6,336,100 to Yamada as applied to claim 1 above, and further view of U.S. Patent No. 6,085,170 to Tsukuda.**

Regarding claim 9, Shub and Yamada substantially disclose the claimed invention, however, the combination does not disclose a commodity cabinet. The

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combination discloses the delivery of a product to a station where the commodity is kept temporarily (Yamada, col. 3, lines 7-8). Tsukuda, on the other hand, teaches the commodity cabinet (col. 9, lines 38-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Shub and Yamada, to include the commodity cabinet, as taught by Tsukuda, in order to store the goods inside the cabinet so that the customer can receive the goods at anytime (Tsukuda, col. 11, lines 19-24).

**Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. in view of U.S. Patent No. 6,085,170 to U.S. Patent No. 6, 609,113 to O'Leary et al.** Shub substantially discloses the claimed invention, however, it does not disclose the arrangement to pay a predetermined amount of money periodically to a customer's account established for the payment agent to make payment in behalf of the customer and the payment agent makes a direct debit of a price regarding the purchasing of the commodity in the customer's account. Shub disclose a payment agency which establishes protocols for the exchange of information (col. 6, lines 17-19). The payment agency is the bank and/or credit card company of the customer and can also be a specialized agency where the customer pays cash in exchange for a receipt (col. 4, lines 13-17). O'Leary, on the other hand, teaches the arrangement as recited above (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the payment arrangement, as taught by O'Leary, in order to pay the seller.

**Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. in view of U.S. Patent No. 6,748,365 to Quinlan et al.** Shub substantially discloses the claimed invention, however, it does not disclose the marketing information, discounts and age/sex information. Quinlan, on the other hand, teaches the marketing information, as recited above (col. 3, lines 26-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Yamada, to include the marketing information, as taught by Quinlan, in order to redeem product rebates (Quinlan col. 1, lines 12-13).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-18 and 65 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication No. 2001/0044785 to Stolfo et al. discloses a private shipping system and method to anonymous users of a computer network.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

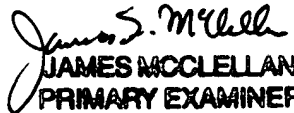
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot  
August 22, 2005

  
JAMES MCCLELLAN  
PRIMARY EXAMINER